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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,015	12/29/2000	Peter Perthou	08914-009001	1179

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EXAMINER	
BARRETT, SUZANNE LALE DINO	
ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/752,015	PERTHOU, PETER	
	Examiner	Art Unit	
	Suzanne Dino Barrett	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

In consideration of the Appeal brief filed 5/5/03 and upon further review of the application, new prior art was discovered which necessitates re-opening of prosecution. Accordingly, the following is a new non-final action on the merits.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Design Patent No. D435,720. Although the conflicting claims are not identical, they are not patentably distinct from each other because the design patent clearly shows all of the claimed structure of the instant utility patent application and the utility patent claims all of the structure shown in the design patent as evidenced by the identical drawings figures in

both he utility application and the design patent. Accordingly, two-way obviousness determination is satisfied.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1,6,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,069,050 in view of Jung 4,903,514, and Momemers 4,523,443 or Sheldon 4,601,185. Chen teaches a flexible web band member 16 having a key ring 12 attached to one end. Jung teaches a keyholder comprising an intermediate member between the member 11 and key ring 15 in the form of a D-ring having a "V" shaped portion connecting one end of the band and the key ring. The D-ring further comprises a gap portion to be attached to the band and a clip means 20/21/22 to clamp the other end of the band together. Jung fails to teach a D-ring having a "U" shaped portion. Momemers teaches a similar key ring comprising a D-ring with a "U" shaped portion 3. Or alternatively, Sheldon teaches both "V" and "U"-shaped rings in Figure 2. It would have been considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and key ring of Chen as taught by Jung since it well known in the key ring art to provide as many intermediate members as desired due to the ease of attaching multiple rings together, and further to substitute a

"U" shape for the "V" shaped D-ring of Jung since the varying shapes of rings are well known and there is no criticality afforded the U-shape. Furthermore, the method limitations of claim 11 are considered inherent to the device of Chen, as modified by Jung, and Momemers or Sheldon.

5. Claims 2-5,7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jung and Momemers or Sheldon, as applied to claim 1 above, and further in view of Miller 1,704,137. Chen fails to teach the ends of the band being joined together as set forth in claim 2. Miller teaches a band 12/14 looped through a key ring 20, fastened along most of its sides by snaps 28 or alternatively by stitching 30, and joined at its ends by a clamp means comprised of stitching 16/30 extending along the entire width of the band. It would have been obvious to one of ordinary skill in the art to modify the band of Chen by providing a fastening along most of its length and stitch clamp means for joining the ends as taught by Miller as a well known alternative manner of constructing the band member and providing strengthening means by doubling up on most of the length, rather than the shortened leg 18D,18E of Chen.

Response to Arguments

6. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection. Initially, it is noted that the discovery of Applicant's previous design patent necessitates a new double patenting rejection as set forth above. Furthermore, as previously discussed, and set forth above, it is maintained that the combination and totality of the teachings set forth in the applied prior art references render the instant claims obvious and rejected. The Chen '050 reference is applied against the claims as the primary reference teaching a flexible band and a key

ring. It is well known in the keyholder art that multiple rings may be attached in series, as desired, to continually add more keys to the keyholder and thus, providing an intermediate member (or several) between the band and the key ring would have been considered obvious to one of ordinary skill in the art in order to accomodate more keys. The suggestion provided in Jung is that intermediate members can be added for mounting additional key rings in order to accomodate more keys. Thus, the conclusion is that given such a teaching, it would have been obvious to provide the keyholder of Chen with an intermediate member for attaching additional key rings. Furthermore, it has been long held that modifying the shape of a structural member, absent a disclosure of criticality of such shape, would have been obvious to one of ordinary skill in the art, especially when the prior art teaches such varying shapes (as evidenced by the cited prior art). Thus, modifying the shape of the intermediate member would have been considered an obvious matter of design choice. Furthermore, the Miller '137 patent clearly teaches a web band having most of its length fastened together and its ends clamped together and fastened by stitching as discussed above. In addition, Applicant's arguments regarding the method limitations of claim 11 are not persuasive. The assembly of the band, D-ring and key ring would have been considered inherent to the use of the device given the rejection of the structure of the device set forth above. Accordingly, claims 1-11 stand finally rejected under 35 USC 103.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the newly cited prior art showing different web band and ring configurations, especially, Chisolm '993 Foo '872, DiSabatino '822.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb